

REMARKS

Claims 13-29 are pending herein. By this Amendment, Claims 1-12 are canceled without prejudice or disclaimer, and new Claims 13-29 are added. Support for the new claims is found in the specification at pages 5-9, in the original claims, and in the drawings. No new matter is added by this Amendment.

In view of the addition of new Claims 13-29, which do not contain improper multiple dependencies, Applicant respectfully requests that search and examination be conducted as to all pending claims.

I. FORMAL MATTERS

The Abstract of the Disclosure was objected to. A new Abstract is submitted that does not use the words "said" or "means". Reconsideration and withdrawal of the objection are respectfully requested.

The specification was objected to regarding the reference numeral of insert (2). Pages 6 and 9 of the specification have been amended to correct the reference numeral. Reconsideration and withdrawal of the objection are respectfully requested.

Claims 5-12 were objected to under 37 C.F.R. 1.75(c) as being in improper form. Claims 5-12 are canceled, thereby rendering the rejection moot. New Claims 13-29 have no improper multiple dependencies. Reconsideration and withdrawal of the objection are respectfully requested.

Claims 1-12 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Claims 1-12 are canceled. New Claims 13-14 and 25-28 are directed to a sole insert; Claims 15-22 are directed to a boot comprising a sole having a sole insert; Claims

23 and 29 are directed to a process of manufacturing a boot; and Claim 24 is directed to a set of at least two boots of different sizes. Regarding Claim 13 and its dependent claims, the use of the term “holding means” is proper under 35 U.S.C. 112, sixth paragraph, and indicates means that work with the two ends of the sole insert. Moreover, the specification indicates that the holding means may be an element of a mating shape to the holding element (e.g., hollow compartments) of the sole insert (specification at page 6, lines 9-15). The scope of the pending claims would be reasonably ascertainable to one of ordinary skill in the art when read in light of the specification and drawings. Thus, the requirements of 35 U.S.C. 112, second paragraph, are satisfied. Reconsideration and withdrawal of the rejection are respectfully requested.

II. REJECTIONS UNDER 35 U.S.C. 102(b)

A. First Rejection Over McKenzie et al.

Claims 1-4 were rejected under 35 U.S.C. 102(b) over McKenzie et al. (U.S. Patent No. 5,493,794). Claims 1-4 are canceled. This rejection is respectfully traversed with respect to the subject matter of the pending claims.

McKenzie et al. discloses a snowshoe and binding. The binding cooperates upon the snowshoe for evenly distributing a user’s weight thereupon (Abstract). Binding 34 is positioned on pivot member 40, which has a first end 42 placed in inboard rail 18 and a second end 44 placed in outboard rail 20 (col. 5, lines 34-37). See FIG. 4.

The Office Action states that McKenzie et al. discloses “an insert for a sole 40”. However, McKenzie et al. does not disclose any boot or any sole of a boot. Thus, pivot member 40 is not disclosed as being inserted into the sole of a boot. Moreover, pivot

member 40 does not have two ends that are located on the lateral edges of the sole of a boot. As shown in the Figures, each end of the pivot member 40 of McKenzie et al. is in an inside edge of a rail of the snowshoe. McKenzie et al. does not disclose a sole insert having two ends, each end being on a lateral edge of the sole of a boot. McKenzie et al. does not disclose each and every element of the claimed sole insert or boot. Thus, the pending claims are not anticipated. Reconsideration and withdrawal of the rejection are respectfully requested.

B. Rejection Over Massicotte

Claims 1-4 were rejected under 35 U.S.C. 102(b) over Massicotte (U.S. Patent 3,344,538). Claims 1-4 are canceled. This rejection is respectfully traversed with respect to the subject matter of the pending claims.

Massicotte discloses snow footwear such as mechanically hinged snow shoes. The shoes comprise a member having an upper 35 for a sole 36 and a heel 37. The sole 36 has a block 40 affixed on its underside. The block 40 has a transverse metal sleeve 41 therethrough for receiving stub shaft 34 and a terminal portion of bolt 22 (col. 2, lines 39-46). See FIGS. 3-4. In this embodiment, the sleeve extends to the edges of block 40, not to lateral edges of sole 36. In another embodiment, the sleeve extends through the sole of shoe 12 as shown in FIG. 2A.

Massicotte does not disclose that the length of a sole insert is independent of size of the boot or that the length of the sole insert is the same for at least two boots of different sizes. The Office Action cites no support in Massicotte or any extrinsic evidence for the assertion that the sole 36 is to be “used in more than one boot size” or that “any boot can be strapped into the sole” (Office Action at page 4). In fact, sole 36

is part of shoe 12 and therefore would change in size as the shoe size increased or decreased, as would metal sleeve 41. In contrast, the claimed sole insert is the same regardless of boot size and is not "sized to fit across the sole". See FIGS. 6a, 6b, 6c, and 7a, 7b, 7c of the present application. Massicotte does not disclose each and every element of the claimed sole insert or boot. Thus, the pending claims are not anticipated. Reconsideration and withdrawal of the rejection are respectfully requested.

C. Second Rejection Over McKenzie et al.

Claims 1-4 were rejected under 35 U.S.C. 102(b) over McKenzie et al. (U.S. Patent 5,493,794). Claims 1-4 are canceled. This rejection is respectfully traversed with respect to the subject matter of the pending claims.

The Office Action points to tube (3) in FIG. 2 as an insert. However, there is no such reference number in FIG. 2 of McKenzie et al. Clarification of this rejection and its relationship to the first rejection over McKenzie et al. is respectfully requested.

D. Rejection Over Aomori

Claims 1-4 were rejected under 35 U.S.C. 102(b) over Aomori (WO 00/13538). Claims 1-4 are canceled. This rejection is respectfully traversed with respect to the subject matter of the pending claims.

Aomori discloses universal shoes that can be used in common for a plurality of fittings. The shoe has a sole portion 14 having at least two through holes 24 penetrating therethrough along the width direction. It appears that element 26 is inserted into the through holes.

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Aomori is directed to a boot for a surf board, not a snowshoe. Further, Aomori does not disclose that the length of a sole insert is independent of size of the boot or that the length of the sole insert is the same for at least two boots of different sizes. The Office Action cites no support in Aomori or any extrinsic evidence for the assertion that the sole is to be “used in more than one boot size” or that the sole is “designed to be used on more than one boot” (Office Action at page 6). The claimed sole insert is the same regardless of boot size and is not “sized to fit across the sole”. See FIGS. 6a, 6b, 6c, and 7a, 7b, 7c of the present application. Aomori does not disclose each and every element of the claimed sole insert or boot. Thus, the pending claims are not anticipated. Reconsideration and withdrawal of the rejection are respectfully requested.

III. CONCLUSION

In light of the foregoing remarks, this application is in condition for allowance, and early passage of this case to issue is respectfully requested. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application.

Enclosed is a check in the amount of \$63.00 for the additional claim fee.

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If there are any discrepancies in the fees, please charge or credit our Deposit
Account No. 501032 (Docket No. GASQ-101).

Respectfully submitted,



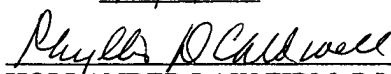
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<p align="center"><u>CERTIFICATE OF MAILING</u></p> <p>I hereby certify that this correspondence dated <u>10/8/03</u> is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on <u>10/8/03</u>.</p> <p align="center"> _____ HOLLANDER LAW FIRM, P.L.C. Suite 305 10300 Eaton Place Fairfax, Virginia 22030</p> <p>Date: <u>10/8/03</u></p>
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